



WINSTON & STRAWN  
PATENT DEPARTMENT  
1400 L STREET, N.W.  
WASHINGTON, D.C. 20005-3502

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**MAR 23 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Jean Servaux :  
Application No. 10/784,034 : DECISION ON PETITION  
Filed: February 20, 2004 :  
Attorney Docket No. 88265-68601 :  
For: Packaging Comprising a :  
Container and a Membrane :

This is in response to the petition under 37 CFR 1.47(b), filed on December 14, 2004. Applicant obtained an extension of time to reply within the fifth month. Accordingly, the petition is timely filed.

The petition is **dismissed**.

Applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing legal representative. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 20, 2004, naming Jean Servaux as the sole inventor. The declaration submitted on filing was missing the signature of Jean Servaux. Accordingly, on May 14, 2004, the Office of Initial Patent Examination mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring an executed declaration, a

\$130.00 surcharge, and proof of authority of the legal representative under 37 CFR 1.44.<sup>1</sup>

In response, on December 14, 2004, applicant filed the present petition, a request for a five-month extension of time to reply, a declaration identifying the deceased inventor, Jean Servaux, and signed by the attorney of record, and paid the requisite fees. In the Statement of Facts, Alain Thomas stated that he presented a copy of the application papers to the legal representative, Chantal Servaux. Chantal Servaux informed Mr. Thomas in her letter of March 5, 2004, that she was unable to sign the declaration because she could not obtain the certificate of inheritance. A copy of the letter accompanies the petition. Mr. Smith stated that Jean Servaux was obligated under Swiss Law to assign all inventions made during the inventor's employment, including the invention claimed in the subject application to Nestec S.A. A copy of the Employment Agreement also accompanies the petition. Lastly, Mr. Thomas asserted that the filing of this application on behalf of the deceased inventor and the legal representative was necessary to preserve the rights of the party and to prevent irreparable damage.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and, (6) proof of irreparable damage. Applicant lacks items (2) and (5) as set forth above.

As to item (2), the Office notes that pursuant to Section 409.03(b)(A) of the Manual for Patent Examining Procedure:

Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or

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<sup>1</sup> The Notice erroneously required proof of authority of the legal representative under 37 CFR 1.44. Effective September 8, 2000, 37 CFR 1.44 was removed and reserved. See 65 FR 54604, Sept. 8, 2000.

agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP Section 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

The declaration submitted on petition fails to identify the name, residence, post office address and citizenship of the legal representative in addition to that of the deceased inventor. Applicant must submit a new declaration with blank signature blocks setting forth the inventor and legal representative by name. The declaration must also identify the countries of citizenship and mailing addresses of both the inventor and the legal representative. Lastly, the declaration must be signed a person authorized by the corporation. The Office reminds applicant that where the declaration is signed by a registered attorney on behalf of a corporation, either proof of the attorney's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney may simply state that he is authorized to sign on behalf of the corporation. The title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

As to item (5), applicant submitted a copy of the Employment Agreement between the deceased inventor and Nestec S.A. as evidence of proprietary interest. However, the copy of the Agreement was not submitted in English. Upon the filing of a renewed petition, applicant should submit a translation of the relevant portions of the Employment Agreement, which evidence the inventor's obligation to assign the subject invention to Nestec S.A.

Further correspondence with respect to this matter should be addressed as follows:

By mail:            Mail Stop Petition  
                    Commissioner for Patents

P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (703) 872-9306  
Attn: Office of Petitions

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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